

REMARKS

Overview

Claims 1-16 and 18-89 are pending in this application. Claims 1, 42, 54 and 56 have been amended. The present response is an earnest attempt to respond to the Office Action of May 8, 2006 and place all claims in proper form for allowance. Therefore, entry of this response and reconsideration of this application is respectfully requested.

Claim Objections

An objection has been raised to claims 2-8, 54, 57, 58, and 59. The basis for the objection is the claims "are combination claims which include a pole. However, they depend from claims which are subcombination claims reciting the pole cover."

This rejection is respectfully traversed. First, claim 54 is a stand alone independent claim which has been part of the application since its inception. It is, therefore, respectfully submitted to be proper.

Second, it is respectfully submitted the other claims under this rejection are likewise proper. The undersigned does not know any authority which precludes an independent claim which claims a specific apparatus and then a dependent claim which includes that specific apparatus in combination with another apparatus. The Examiner is correct that Applicant's claim 1, for example, defines solely the apparatus that is referred to as a pole sleeve apart from the pole. The Examiner is also correct that claims 2-8 add in a pole to the apparatus. While claim 1 versus claims 2-8 may be subject to a restriction or species election requirement as subcombination and combination, they are proper with regard to § 112. For example, it is long established that an Applicant could claim the specifics of a carburetor for an internal combustion

engine in an independent claim and then claim it in combination with the entire internal combustion engine in a dependent claim. While those two claims may be subject to a restriction requirement, they are proper ways to claim an invention in different ways. The Applicant should have the option of claiming both the specific part and then its combination with other components. The Applicant should be entitled to try to get coverage and thus sue for infringement on anyone that makes, uses or sells the specific part, but also claim it in combination with components with which it is traditionally used to have the ability to sue the manufacturer of the specific part (which may not put it in combination with the engine), as well as sue the company that makes the engine and puts the carburetor on it.

As set forth in the MPEP, a dependent claim is simply a shorthand way of writing an independent claim. Thus, just as original claim 54 specifically define the combination that includes a pole and a covering member on the pole, each of claims 2-8, 57-59 does the same thing. The only difference is it is in an abbreviated format of a dependent claim including all of the limitations of its base claim and any intervening claims.

Claim Rejections Under 35 U.S.C. § 103

The Office Action sets forth three different obviousness rejections. They will each be addressed in the order presented in the Office Action.

Claims 1-16, 18, 19, 21, 31-50, 52-54 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,340,790 ("Gordin") in view of U.S. Patent No. 4,543,764 ("Kozikowski"). These references were cited in prior Office Actions.

Applicant earnestly traverses this rejection. The Examiner takes the position that Gordin "discloses a sleeve positionable around a part of an existing pole". (Office Action, page 2, last 3 lines on page). This is not accurate.

Gordin does disclose a multi-section pole. Each section is tapered. Therefore, each succeeding section slip fits a ways over a preceding section and overlaps it. Certainly, it is accurate to say that adjacent sections have some overlap. However, they are all part of the pole. As made clear in Applicant's specification, the context of "sleeve" is a covering over a pole. An interpretation of the overlap between adjacent sections of the pole in the Gordin reference is not a fair or accurate interpretation of the language of claim 1. In other words, claim 1 has specific language defining a pole. An additional element is a sleeve or covering over the pole. The Gordin reference discloses only a pole. This is corroborated by the art of record in this application. Several of the patents either cited by the Applicant or the Examiner deal with multi-section poles that have portions that overlap one another. However, in each case, it is clear to one skilled in the art that collectively the sections are the pole. See, for example, U.S. Patent Nos. 3,034,209, 3,270,480, and 5,117,607.

The Office Action takes the position that Applicant's claims 1 and 42 are obvious based on a combination of Gordin and Kozikowski. The Examiner states "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin by adding a vinyl sleeve, as disclosed by Kozikowski in order to prevent rust from destroying the pole." Office Action, page 3, first partial paragraph. It is true that a flexible material such as fiberglass, polyvinyl chloride, epoxies, polyesters, or other materials can be used for jacket 24 in Kozikowski. But, it is likewise true the jacket 24 is intentionally spaced from a wood pole "to create an annular void of the proper width" (col. 4, lines 48-49) into which can be poured an

epoxy material to effectuate structural repair of a deteriorated area of a wood pole. Column 4 and Figure 2 of Kozikowski further show that holes 16 are drilled through the pole at the deteriorated area, vertical spacer rods, almost like rebars, are stapled to the exterior of the pole, and the epoxy is poured in to encapsulate those spacer rods, fill in the drilled holes 16, and fill in any cracks or discontinuities to effectuate the repair.

A *prima facie* case of obviousness does require both that the combination of references suggest combination with one another and, once combined, they suggest or teach the claimed invention to one of ordinary skill in the art.

There is no suggestion or teaching of combination of Gordin and Kozikowski. Gordin deals primarily with hollow metal poles that are in sectional format and which support wide area lighting fixtures on a concrete stub base that is secured in the ground. Kozikowski is concerned with repairing deteriorated sections of metal or wood poles. The problem addressed with the present invention is how to protect the outer surface of a metal pole from corrosion and/or change the exterior aesthetics of such a pole. Thus, Kozikowski is only relevant after there has been corrosion or deterioration of a pole. The present invention is related to preventing that from occurring. There is no suggestion of combining the two to address the problem addressed by Applicant's invention.

But even if combined, there is no teaching of the specific combination of Applicant's claims 1 and 42. For example, Applicant's claim 1 defines "a covering layer of plastic material" that is placed over a pole. It specifies the layer is over the surface of the pole. As discussed above, Gordin does not have any such layering cover. And, Kozikowski has a combination of vertical supports, an outer jacket defining a space away from the pole, then epoxy material that is poured into and hardens and adheres to the pole for structural repair. Therefore, a combined

teaching of Gordin and Kozikowski would be no more than what Kozikowski teaches -- namely, to repair a deteriorated section of a metal pole you would somehow attach vertical metal structural rods to its exterior, form a jacket spaced from that portion of the pole, and pour in and let harden an epoxy substance that encapsulates the vertical rods to strengthen that area of the pole. This is not Applicant's claim 1 or claim 42. It would be counter productive and cost ineffective to try to prevent corrosion on a metal by putting a jacket and an epoxy layer along the whole pole. But, this is neither the teaching nor suggestion of Kozikowski. Kozikowski repairs a damaged section of a pole.

Likewise, there is no teaching or suggestion of a covering layer to protect against corrosion in Gordin. All of its sections are metal. There is no suggestion or teaching of utilizing some plastic portion of the pole. Indeed, it would be catastrophic to utilize a plastic thin cover as a structural support for such a pole.

Therefore, it is earnestly and respectfully submitted that the combination of Gordin and Kozikowski does not present a *prima facie* case of obviousness relative to Applicant's claim 1.

To further highlight the difference between Applicant's claim 1 and the cited references, claim 1 has been amended. Note that it has the following concepts:

a. The covering layer of plastic is clarified to be in conforming relationship around the pole exterior. Gordin doesn't teach any plastic layer around the exterior of a pole. Kozikowski does not teach a plastic layer in conforming relationship on the exterior of the pole. As mentioned, Kozikowski does have the outer jacket 24 which could be plastic but it is intentionally spaced apart from the pole. The substance in conforming relationship is the epoxy that hardens between the jacket and pole.

b. The layer is a fraction of an inch thick and is for the protection of the pole. As can be seen, the entire structure of Kozikowski adds substantial width to the pole.

The bottom line is that the problem addressed by the present invention is not the problem addressed by either Gordin or Kozikowski and neither one suggests the solution of Applicant's claims 1 and 42.

It is furthermore pointed out that Applicant's claim 42 is a method claim. Under 35 U.S.C. §§ 100 and 101, it is not a basis for rejection to argue a known structure is utilized in the methodology. There has to independently be a teaching or suggestion by the cited references of the method. For the same reasons expressed in support of claim 1, neither Gordin nor Kozikowski teach or suggest covering the pole with a plastic material that is a fraction of an inch thick to protect the exterior of the pole. Neither teach or suggest that the covering be in a conforming relationship to the exterior. Neither suggest that the method of protecting the exterior of the pole as a goal or object. Therefore, this is an independent basis for patentability of method claim 42.

Also, claim 54 is not taught or suggested by the cited references. As previously discussed, claim 54 is the combination of the pole with the very thin cover to protect the exterior of the pole.

The remaining claims under this rejection are dependent from independent claims 1, 42, 54 and are therefore submitted to be allowable for the reasons expressed in support of those independent claims.

The Examiner has also rejected claims 20, 22-27, 51, 55-65, 67-81, and 84-89 alleging those claims are obvious based on a combination of Gordin and Kozikowski and further in light of the teaching of Oakes, U.S. Patent No. 3,968,561. This rejection is also respectfully traversed.

Claims 20, 22-27, 51, and 55 are dependent from one of independent claims 1, 42, or 54, and therefore are submitted to be allowable for the reasons as expressed in support of those claims.

The Oakes patent shows a thin metal member that is formed by multiple sections that interlock edges. But its entire teaching is that the metal member is essentially a mold that is filled with rigid light weight synthetic plastic foam to produce any of a variety of structural members. It has no teaching of addressing the issue of protecting the outer surface of a metal pole. In fact, it teaches away from the claims to a thin plastic covering layer over a metal pole. Essentially it is a mold that is filled with foam that hardens into a rigid structural material.

Independent claims 56 and 73 fall under this rejection. However, each has been amended in similar fashion to claims 1 and 42 and are therefore believed allowable for those same reasons expressed in support of claims 1 and 42. Additionally, claims 56 and 73 specifically recite that the plastic thin layer is formed into a truncated cone matching the taper of a tapered pole. Gordin has no plastic covering layer at all. Kozikowski shows a straight, not tapered, pole. Oakes does not show any formation into a taper. It is therefore submitted this is an independent grounds for allowability of claims 56 and 73. The remaining claims are dependent on claims 56 or 73 and submitted to be allowable for the reasons expressed in support of those claims.

Claims 28-30 and 82-73 have been rejected as obvious based on Gordin in view of Kozikowski and further in view of Swanson, U.S. Patent No. 4,092,079. These claims are dependent from previously discussed independent claims and are submitted to be allowable for the reasons expressed in support of them. Furthermore, Swanson is a variation on Kozikowski. It is a system for repair of poles. It uses an outer, what it calls "sleeve 38". Push plates 48 can be moved towards the pole when sleeve is around it to center the sleeve in a spaced apart position from the pole. A material is then injected into the space between the outer sleeve and the pole.

As shown in Swanson, the pole must actually be cut apart. Sleeve 38 is a cylinder that obviously is a very rigid material. It teaches the use of the multiple bolts and push plates and then utilization of the grout to effectuate a repair on that split section of the pole. Thus, Swanson adds nothing to the teaching of Gordin and Kozikowski and does not create a *prima facie* case of obviousness.

Claims 65 and 66 have been rejected on the basis of Gordin, Kozikowski, Oakes and Swanson. These are dependent from independent claims previously discussed and therefore are submitted to be allowable for reasons expressed in support of those independent claims.

Comment on Examiner's "Response to Arguments"

At pages 11-12 of the Office Action, the Examiner discusses Applicant's prior arguments. Applicant acknowledges the concept that the Gordin reference teaches a conical overlapping portion of one section of its pole over another section of its pole. However, Applicant's claims are not directed to that concept. They specifically state a plastic covering layer is applied to the exterior of a pole to protect the exterior. Gordin has no such layer.

Kozikowski has a plastic layer but it is not applied to the exterior of the pole.

With regard to the negative limitations in the predecessor claims of Applicant's application, MPEP § 2173.05(i) specifically states that negative limitations are possible. The test is whether one of ordinary skill in the art would understand the limitation. Applicant's specification clearly describes a thin plastic covering layer over the exterior of a hollow tubular metal pole for the purposes of protecting the exterior surface. It is clear from Applicant's specification this thin plastic layer has no structural support for the pole. The purpose is not to

repair or add structural support. The purpose is to protect and/or change the outward aesthetic appearance of a pole.

The practical reality is that economics come into play regarding the solution to this problem. As Applicant's specification states and describes, one approach is to paint the exterior of the metal pole. That is a convention, state-of-the-art solution. It can be done relatively economically.

The Gordin reference (commonly owned by the owner of the present application) teaches nothing about protecting the exterior of the metal pole. Kozikowski and Swanson teach nothing about protecting the exterior of a metal pole. They both address structural repair of a deteriorated portion of the pole. Oakes simply describes a thin outer shell as a mold for foaming structural material. The negative limitations have been withdrawn from most of the claims in an effort to move the application to allowance. However, it still is material to an evaluation of obviousness that the problems solved by Applicant is not to add to structural deport of the pole but rather a practical cost effective way to protect the exterior. As noted in Applicant's specification, paint has been found to be less than ideal because it can be scratched or chipped. This can occur when transporting the pole pieces before installation or after installation. The Examiner takes the position that even though the cited art like Kozikowski, Swanson and Oakes describe outer jackets used as basically a mold for structurally supporting the material, that the outer jacket could be used in a manner to meet the objectives of the claimed invention. However, there is no teaching or suggestion of this that has been cited specifically in these patents. Therefore, it is respectfully submitted that the claims, as amended, are allowable over the cited art.

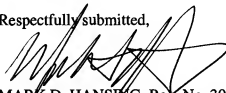
Conclusion

It is respectfully submitted all matters raised in the most recent Office Action have been addressed and remedied and that the application is form for allowance.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and passage to issuance is respectfully requested.

Respectfully submitted,



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